REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 3, 2005 ("Office Action"). At the time of the Office Action, Claims 17-24, 41-48, 65-72, and 81-87 were pending in the Application. In the Office Action, the Examiner rejects Claims 17-24, 41-48, 65-72, and 81-87 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,339,826 issued to Hayes, Jr. et al. ("*Hayes*") in view of U.S. Patent No. 6,105,027 issued to Schneider et al. ("*Schneider*").

In this Response to Office Action, Applicant amends Claims 17, 20 ,21, 41, 44, 45, 65, 68, 69, 81, 82, 84, 86, and 87. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

The Claims are Allowable over the *Hayes-Schneider* Combination

Applicant respectfully submits that the proposed *Hayes-Schneider* combination does not disclose, teach, or suggest each and every element of Applicant's claims. For example, independent Claim 17 of the present application, as amended, recites:

> A configuration management system, comprising:
> a configuration device configured to perform configuration management functions on objects within said configuration management system, the objects comprising items that are associated with the development of a product;
> a display device configured to display a representation of said objects in a presentation having a tree display of objects in said configuration management system and a content display that displays items selected in said tree display;
> a server machine for executing said configuration device and producing display information for said representation of said objects within said configuration management system; and
> a network interface connecting said server machine to a network, wherein said network interface is a web interface and said network is one of the Internet and an intranet, wherein said server machine transmits information produced by said configuration device and said display information over said network for display on a remote computer, wherein the transmitted information

includes one of an Active X component, Visual Java program, Java applet, and PERL program configured to utilize the information produced by said configuration device in said presentation.

In the Office Action, the Examiner relies on *Hayes* for disclosure of a configuration device. Applicant respectfully submits, however, that *Hayes* does not disclose, teach, or suggest "a configuration device configured to perform configuration management functions on objects within said configuration management system, the objects comprising items that are associated with the development of a product," as recited by Claim 17. To the contrary, *Hayes* relates generally to a "client-server system for maintaining a user desktop consistent with server application user access-permissions." (Title). Specifically, *Hayes* discloses a "profile management administrative operating environment" that includes an administrator client network computer 200 and a server 202. (Figure 2; Column 7, lines 46-50). With regard to profile management functions, *Hayes* discloses:

> Profile manager 206 on the client side allows the administrator to configure user applet preferences at both user and group levels. The administrator can create new users and group hierarchies, add users to different groups, specify applet permissions for each group and for individual users. And the administrator can configure applets in the context of an individual user or a group. The administrator can add, delete and reset passwords for users.

(Column 7, lines 54-61). Thus, *Hayes* is limited to a client-server system that allows an administrator to configure user preferences and user permissions so that users may gain access to applications using a desktop computer. (*See generally*, Abstract, Column 7, lines 1-67; Column 8, lines 7-9). As such, the "profile management" functions and tools of *Hayes* cannot be said to be the equivalent of Applicant's "configuration device configured to perform configuration management functions on objects within said configuration management system, the objects comprising items that are associated with the development of a product," as recited by Claim 17.

Independent Claims 20, 21, 41, 44, 45, 65, 68, 69, 81, 82, 84, 86, and 87 recite certain limitations that are similar to the features discussed above. As examples, Claims

20 and 21 recite "a configuration device configured to perform configuration management functions on objects within said configuration management system, the objects comprising items that are associated with the development of a product." As further examples, Claims 41, 44, 45, 65, 68, 69, 86, and 87 recite "managing performance of configuration management functions on objects within said configuration management system, the objects comprising items that are associated with the development of a product." Thus, for reasons similar to those discussed above with regard to Claim 17, Applicant respectfully submits that the *Hayes-Schneider* combination does not disclose, teach, or suggest each and every element as set forth in Applicant's Claims 20, 21, 41, 44, 45, 65, 68, 69, 81, 82, 84, 86, and 87.

Furthermore, Applicant respectfully submits that independent Claims 20, 21, 41, 44, 45, 65, 68, 69, 81, 82, 84, 86, and 87 recite additional features and operations that further distinguish the art. For example, independent Claim 20 recites "a report generator configured to produce at least one of access reports, version control reports, and package based reports based on at least one selected of said objects, wherein each of said reports generated by said report generator are formatted as HTML documents and sent via said network interface by said server machine for display on said remote computer." As another example, independent Claim 21 recites "a report generator configured to produce at least one of access reports, version control reports and package based reports based on at least one selected of said objects within said configuration management system." Claims 44 45, 68, 69, and 82 recite certain limitations that are similar to those of Claims 20 and 21.

Applicant notes that the Office Action does not include an explicit rejection of Claims 20, 21, 44, 45, 68, 69, and 82. Applicant assumes for purposes of responding to the Office Action, however, that this deficiency is merely an oversight and that the Examiner intended to rely upon *Hayes* for disclosure of the recited report generator. Applicant makes this assumption based on the Examiner's rejection of dependent Claim 22.

With respect to Claim 22, the Examiner relies upon Column 15, lines 5-67 of *Hayes* for disclosure of the functions of a report generator. This portion of *Hayes* relates to Figures 8 and 9 generally. Applicant respectfully submits, however, that the cited portion of *Hayes* does not disclose, teach, or suggest Applicant's claim limitations. To the contrary, Figure 8 relates generally to a method for checking user permissions and Figure 9 relates generally to a method for updating preferences. Specifically, *Hayes* discloses that "the desktop checks each of these applets appearing outside of the applet window against the list of applets from the server to which the user has access." (Column 15, lines 19-22). "If the applet appears in the list, the icon for the applet is placed on the desktop 810 in the same position as before. If the user no longer has access to the applet, the applet is removed from the desktop's preferences at step 814 and removed from the Profile-ManagementProperties object P." (Column 15, lines 22-27). With regard to Figure 9, the cited portion of *Hayes* merely discloses allowing "an administrator running a configuration applet to configure preferences for an applet for other users or group of users." (Column 15, lines 37-67). Accordingly, Applicant respectfully submits that the report generating elements and operations of Claims 20, 21, 44, 45, 68, 69, and 82 are not disclosed in the cited portions of *Hayes*.

As another example, independent Claim 84 recites "a configuration device management functions on objects within said configuration management system, wherein said objects within said configuration management system include versions associated with the development of a product" (emphasis added). Again, the Office Action does not include an explicit rejection of the above-recited claim language. Applicant assumes for purposes of responding to the Office Action, however, that the Examiner intended to rely upon *Hayes* for disclosure of the recited "versions." Applicant has shown above, however, with regard to Claim 17 that *Hayes* is limited to a client-server system that allows an administrator to configure user preferences and user permissions so that users may gain access to applications using a desktop computer. (*See generally*, Abstract, Column 7, lines 1-67; Column 8, lines 7-9). Accordingly, for reasons similar to those

discussed above with regard to Claim 17, Applicant respectfully submits that the proposed *Hayes-Schneider* combination does not disclose, teach, or suggest "a configuration device management functions on objects within said configuration management system, wherein said objects within said configuration management system include versions associated with the development of a product," as recited in Applicant's Claim 84 (emphasis added).

As another example still, independent Claim 84 recites "a registration device configured to register an application as associated with a type of version" and "a view version device configured to, check out a version from said configuration management system, and execute an application registered as associated with the version checked out." Independent Claims 86 and 87 recite certain limitations that are similar to those of Claim 84. With respect to Claim 84, the Examiner relies generally on Columns 11 and 12 of *Hayes* for disclosure of the functions of Applicant's registration and view version devices. The relied on portion of *Hayes*, however, merely discusses the treatment by the *Hayes* system of preferences and permissions. Although the cited portion of *Hayes* discusses registering, it does so in the context of requiring an "applet to register with ProfileManagementProperties 510" before the applet can run in the profile management framework. (Column 12, lines 29-32). There is no disclosure, however, in *Hayes* of "a registration device configured to register an application as associated with a type of version," as recited in Claim 84 (emphasis added) and similarly recited in Claims 86 and 87. And, certainly there is also no disclosure of "a view version device configured to, check out a version from said configuration management system, and execute an application registered as associated with the version checked out," as recited in Claim 84 and similarly recited in Claims 86 and 87.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 17, 20, 21, 41, 44, 45, 65, 68, 69, 81, 82, 84, 86, and 87, together with the dependent claims that depend from independent Claims 17, 20, 21, 41, 44, 45, 65, 68, 69, 81, 82, 84, 86, and 87.

The Proposed *Hayes-Schneider* Combination is Improper

With respect to the Examiner's proposed combination of *Hayes* with *Schneider*, even if all elements of a claim are disclosed in various prior art references, which Applicant disputes above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill in the art at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an Applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.[1] According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight

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[1] Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a motivation to combine the references that create the case of obviousness. *See id. See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

> Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

In this case, the mere possibility that the teachings of one reference -- *Schneider* -- might improve the teachings of another reference -- *Hayes* --, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to combine these references. The Examiner concludes on page 6 of the Final Office Action that it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the client-server system of *Hayes* to include "a display device configured to display a representation of objects in a presentation having a tree display of objects in configuration management system, and a content display that displays items selected in tree display as taught by *Schneider* . . . in order to provide a user interface . . . that allows intuitive navigation and interpretation of the tree structure." The Examiner's summary conclusion, however, amounts to mere speculation and does not provide the suggestion or motivation necessary to make the proposed combination.

Applicant respectfully submits that in making this unobvious leap the Examiner has used the type of hindsight reconstruction explicitly forbidden by the M.P.E.P. and Federal Circuit.

For at least these reasons, Applicant respectfully submits that the rejections of Claims 17-24, 41-48, 65-72, and 81-87 are improper and should be withdrawn.
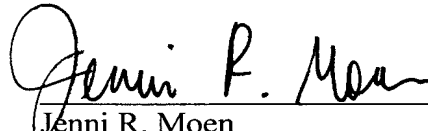
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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